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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,071	02/04/2004	Charles D. Huston	5863-00203	1712

7590  
Conley Rose, P.C.  
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Austin, TX 78768-4908

EXAMINER
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ISSING, GREGORY C

ART UNIT	PAPER NUMBER
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3662

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/11/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/772,071

Applicant(s)

HUSTON ET AL.

Examiner

Gregory C. Issing

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 2/20/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-36,38,39 and 41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-36,38,39 and 41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                           | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

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1. Applicants' disclaimer of priority of U.S. Patent 5,364,093 is acknowledged.
2. The Declarations of C. Huston and C. J. Herbert under 37 CFR 1.132 filed 2/20/07 <sup>are</sup> ~~is~~ sufficient to overcome the rejection of claims 21-36, 38-39, and 41 based upon Dimitridis et al (5,664,948). However, since Dimitridis et al was cited as an alternative teaching in each rejection, the rejections are maintained.
3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).  
A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.  
Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).
4. Claims 21-36, 38, 39, and 41 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 5,364,093 in view of either one of Paul (5,524,081) or Dudley (5,326,095). The rejection is set forth in the previous Office Action.
5. Applicants argue that the prior patent is directed to determining distances whereas the instant claims are directed to displaying advertising messages at advertising locations and thus the patent does not provide any suggestions regarding the instantly claimed subject matter. Applicants' statements that Paul relates to radio broadcasts of messages and that Dudley relates to tag proximity based messages and thus lack any motivation or suggestion to combine is not persuasive and does not account for the suggestions and reasons provided by the Office Action. Thus, the rejection is maintained.
6. Huston teach a method and system of using GPS on a golf course including the positioning of a remote receiver on a golf course, determining the position of the remote receiver using GPS, the comparison of instant GPS-determined position to stored locations (cup and or hazards) and a subsequent display of information on the basis of the comparison. Paul teach the conventionality of

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location based retrieval of information from a stored database of information including pro's notes and tips on a golf course. Dudley teach the conventionality of providing location-based presentation of advertising messages on a golf course. Thus, it would have been obvious to the skilled artisan at the time the invention was made to modify Huston by additionally providing location based retrieval of additional information in view of the teachings of Paul who suggests presenting information in addition to distance. Moreover, Dudley makes obvious to the skilled artisan the presentation of location based advertising messages on a golf course.

7. Applicants traverse the double patent rejection since they cannot find a single claim of the '093 patent that would render obvious the present claims obvious therefrom since all of the instant claims are directed to displaying an advertising message. The applicants' arguments have been considered but are not persuasive. Huston '093 discloses a method and system for use on a golf course and includes the steps, as exemplified by claims 1, 7, 8, and 10 of "positioning a remote global positioning satellite receiver near a golf ball", "determining a position of the remote receiver using the global positioning satellite system" storing the position of each cup" and hazards in a memory and displaying a message such as a distance based on a comparison of the instant position and the stored memory locations. Additionally, the system includes a GPS receiver, processor, memory, and display. While Huston '093 does not display an advertising message based upon the comparison of the instant GPS position and a stored advertising location, such is made obvious to one of ordinary skill in the art in light of the secondary teachings wherein the secondary teachings show the conventionality of location based messaging wherein specific stored messages are retrieved for display based on position as exemplified by Paul and specifically the location-based retrieval of advertising messages as exemplified by Dudley.

8. Claims 21-33, 35, 36, 38, 39 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul in view of Dudley.

9. The rejection is set forth in the previous Office Action.

10. Applicants traverse the rejection on the basis of the alleged failure of the prior art to suggest the proposed combination, the combination is improper since the operating principle of Dudley is different than Paul and the claim limitations are not taught or suggested even if the references are combined.

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11. The applicants' arguments have been considered but are not deemed to be persuasive for the following reasons. Regarding the alleged failure of the prior art to suggest the proposed combination, the argument is not convincing since Paul, who teaches retrieval of information for presentation on a golf course clearly provides a suggestion to retrieve information stored in a storage element on the basis of position, whereby the position is determined via GPS. Dudley is also directed to retrieval and presentation of stored information to a golfer on a golf course wherein the retrieved information is directed to advertisements. Since both references are directed to a similar environment, on a golf course, and directed to similar operations, retrieval of stored information on the basis of position, the two references are clearly related prior art references available to one having ordinary skill in the art. In fact, Paul additionally shows the desire for the golfer to be provided with advertising messages, albeit via a radio broadcast. Dudley provides a simple teaching of providing advertising messages to a golfer based on the proximity to a buried tag which inherently is based on the provision of the golfer being at a predetermined position. Thus, the suggestion is deemed to be taught and suggested by each of the references.

12. The applicants' argument that the proposed combination would change the principle of operation is not convincing. Firstly, there is no change in the operation of Paul since the modification is simply that one of the stored messages is representative of an advertising message. The teaching to be gleaned from Dudley is simply that position-based retrieval of advertising messages is known, and is particularly known on a golf course. That Paul suggests advertisements via radio broadcast does not change the principle of operation in any way, and in fact both forms of presenting advertising messages could be provided with no change in operation whatsoever.

13. The applicants' argument that the claim limitations are not suggested by the combination of prior art even if the combination is proper is not persuasive. The applicants' support for such argument is non-existent and merely alleges that there would be no motivation combine.

14. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Paul in view of Dudley as applied to claim 33 above, and further in view of Bonito et al.

The rejection is set forth in the previous Office Action.

Applicants do not address the rejection specifically, relying on the arguments set forth above.

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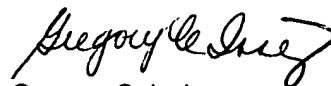
15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory C. Issing whose telephone number is (571)-272-6973. The examiner can normally be reached on Monday - Thursday 6:00 AM- 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Tarcza can be reached on (571)-272-6979. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Gregory C. Issing  
Primary Examiner  
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